



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,274	10/09/2001	Jacques R. Francoeur	7109-001 US	1259

7590 11/02/2004

Jacques M. Dulin, Esq.
Innovation Law Group, Ltd.
224 W. Washington St.,
NetPort Center, suite 201
Sequim,, WA 98382-3338

EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,274

Applicant(s)

FRANCOEUR ET AL.

Examiner

Mary Cheung

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. This action is in response to the application filed on October 9, 2001. Claims 1-10 are pending. Claims 1-10 are examined.

Priority

2. In the Declaration, applicant claimed benefit of the provisional application 60/238,541, filed on October 7, 2000. The correct provisional application number should be 60/238,564, filed on October 7, 2000. Furthermore, the benefit claimed by the applicant for the priority date October 7, 2000 is not granted because the present application filed on October 9, 2001 after expiration of the provisional application. The correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "mapping, for each evaluated risk level in each category, a risk mitigation segment architecture" in lines 13-14 of the claim. Claim 1 further claims "risk mitigation technique" line 15. It is not clear what "a risk mitigation segment architecture" and "risk mitigation technique" are, and how they are related to rest of the claimed components.

Art Unit: 3621

Claim 10 is parallel with claim 1, and it incorporates the similar ambiguities as claim 1; thus it rejected for the similar reason.

Claims 2-9 are rejected for incorporating the errors of their respective base claim 1 by dependency.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-9 only recite an abstract idea. The recited steps merely disclosing design e-business process does not apply, involve, use, or advance the technological arts since all of the recited steps **can be performed in the mind of**

Art Unit: 3621

the user or by use of a pencil and paper. The recited steps only constitute an idea of how to better design e-business processes.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention constructing a verifiably secure, authenticable, and legally enforceable e-business process.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-9 are deemed to be directed to non-statutory subject matter. Applicant is advised to implement technology into the claims in order to overcome this rejection, such as "electronically analyzing the chain of events...", "electronically evaluating each step of...", "electronically mapping...", etc.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U. S. Patent 6,658,568 in view of King et al., U. S. Patent 5,704,045.

As to claims 1 and 10, method of design of a verifiably secure, authenticable, and legally enforceable e-business process comprising the steps of, and an Internet

Art Unit: 3621

business method for delivery of digital trust services for e-commerce to users of e-business processes (column 17 line 33 – column 18 line 46 and Figs. 4-6):

- a) establishing a website having secure web pages assignable to individual users (column 7 lines 48-67);
- b) providing via said pages at least one of consultation, communication, services, information, education and links relating to (column 10 lines 17-61 and Figs. 4-6):
 - i) analyzing the chain of events occurring in said e-business process to identify a sequence of event chain steps (column 91 line 51 – column 92 line 65);
 - ii) evaluating each step of said event chain for nature and level of risk in each of the following risk categories (column 24 line 55 – column 25 line 25):
 - a. identity risk (col.18 lines 18-20; col.35 line 35-col.36 line 49);
 - b. information integrity risk (col.17 lines 21-29; col.113 lines 1-8);
 - c. time-of-event risk (col.35 line 35-col.36 line 49; col.44 lines 49-65);
 - d. enforceability risk (col.12 lines 5-15; col.53 lines 14-29; col.65 lines 1-8);
 - e. confidentiality risk (col.27 lines 58-65; col.58 lines 30-33);
 - f. personal information privacy risk (col. 31 lines 30-52; col.58 lines 30-33);

Art Unit: 3621

iii) mapping, for each evaluated risk level in each category, a risk mitigation segment architecture (column 10 lines 17-61 and column 24 line 55 – column 25 line 25 and column 35 line 35 – column 36 line 49);

iv) generate a digital receipt that is independently verifiable by a trusted third party as to time, sequence and nature of said events, and provide information about said events and said architecture itself that has verifiable integrity for legal enforceability as a verifiable digital chain of trust for said e-business process (column 39 line 36 – column 40 line 6 and column 41 lines 24-32 and column 47 lines 27-61 and column 64 line 60 – column 65 line 8).

Ginter does not specifically teach selecting, for each segment, at least one risk mitigation technique sufficient to provide a preselected level of risk reduction. However, this matter is taught by King as techniques for reducing level of risk at a predetermined level (column 13 line 59 – column 14 line 21 and column 22 lines 34-40). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to allow Ginter to include the feature of providing techniques for a predetermined level of risk reduction for increasing possibilities of business success.

As to claim 2, Ginter teaches wherein said segments are:

- a) Trusted Identity Authentication (who) (col.18 lines 18-20; col.35 line 35-col.36 line 49);
- b) Trusted Information Integrity (what) (col.17 lines 21-29; col.113 lines 1-8);
- c) Trusted Time (when) (col.35 line 35-col.36 line 49; col.44 lines 49-65);

Art Unit: 3621

- d) Trusted Digital Receipt (how) (col.12 lines 5-15; col.39 line 36-col.40 line 6; col.53 lines 14-29; col.65 lines 1-8);
- e) Trusted Access (col.27 lines 58-65; col.58 lines 30-33);
- f) Personal Information Privacy (col. 31 lines 30-52; col.58 lines 30-33).

As to claims 3-9, Ginter further teaches building blocks for the plurality of segments, such as digital fingerprint and time stamps (column 35 line 35 – column 36 line 49). Ginter does not specifically list all the building blocks for the plurality of segments as claimed in claims 3-9. However, it would have been obvious to one of ordinary skill in the art to enhance the list of the building blocks for the plurality of segments based on customer's design choice for the e-business to better meet the customer's needs for building a successful business.

Conclusion

9. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3621

Walker et al. (U. S. Patent 5,862,223) discloses a cryptographically-assisted commercial network system designed to facilitate and support expert-based commerce.

Davis (U. S. Patent 6,219,423) discloses digitally signing a digital agreement between remotely located nodes.

Bowman-Amuah (U. S. Patent 6,370,573) discloses managing an environment of a development architecture framework.

Yokoyama et al. (EP 1 065 618 A2) discloses workflow system with business process definition.

Art Unit: 3621

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room 1B03.

Mary Cheung
Patent Examiner
Art Unit 3621
October 28, 2004

